

Figs. 8-12.

In the restriction requirement, the Examiner set forth a restriction of the claimed invention to one of two groups of distinct inventions under the provisions of MPEP 806.05(h). Additionally, the Examiner indicated that Applicant must further elect one of two species depending on the elected groups.

Applicant notes that the Examiner failed to set forth the correct legal standard for restriction in a national stage application and that the restriction requirement is entirely improper. The correct standard for supporting a restriction requirement in this application is PCT Rule 13.1 and 13.2 (MPEP §§ 1850 and 1893.03(d)) by establishing that the claims lack the same or corresponding special technical feature.

The groups delineated by the Examiner are as follows:

Group I, claims 11-21 and 31-37, asserted to be drawn to a process of using the extraction device; and

Group II, claims 22-30 and 38-42, asserted to be drawn to a container with a straw.

The Examiner further indicated that two species are disclosed for each group and that Applicant must further elect one of these species per group. Specifically:

For Group I, Species I is shown Figs. 13-18 and Species II is shown in Figs. 19-24; and

For Group II, Species I is shown Figs. 3-7 and Species II is shown in Figs. 8-12.

The Examiner asserted that the inventions of Groups I and II, while neglecting to note that they have the same or a corresponding technical feature, was nevertheless restrictable

because group I represents a process of using a product and group II represents the product and that “the product as claimed can be used in a materially different process of using that product.

As the Examiner has failed to base the restriction requirement on the correct standard enunciated in PCT rules 13.1 and 13.2 pursuant to MPEP §§ 1850 and 1893.03(d), Applicant respectfully submits that the restriction requirement is improper and respectfully traverses the restriction requirement.

In this regard, Applicant submits that the Examiner’s basis for the restriction is improper for the following reasons: first of all, the Examiner has failed to properly construe and consider the claims under the “special technical feature” standard and, furthermore, based upon this standard, the restriction is clearly improper. The standard, as described clearly in MPEP §§ 1850 and 1893.03(d), is not whether one group of claims has a feature which is not in another group or whether a particular feature of one claim may be found in the prior art, but whether the groups can be read to have a common technical relationship, i.e., whether a special technical feature is common to the groups. Accordingly, if each of the groups can be read to have a common special technical feature or relationship, then they cannot be restricted.

In this case, the technical relationship or technical features common to both groups I and II are numerous and include *the straw, the straw-supporting member, the container, and the cover*. This is clearly evident from independent claims 11, 22, 31 and 38.

Furthermore, MPEP § 1850 makes clear that a species election based on the figures

is entirely improper and inconsistent with the unity of invention standard. For example, paragraph "A" makes clear that dependent claims cannot be separated from independent claims because the "unity of invention" standard must be evaluated on the basis of *independent claims only*. Accordingly, since the only independent claims are 11, 22, 31 and 38, and since claims 12-21, 23-30, 32-37 and 39-42 depend from these claims, none of the claims can be properly restricted as species under the unity of invention standard. Moreover, Applicant submits that any species election, much less, one that is based upon the specification disclosure or drawings, is an improper basis for restriction under the unity of invention standard.

Accordingly, Applicant submits that under the "unity of invention" standard, the Examiner has set forth no proper basis for restriction of the invention to any of the groups and to any of the species.

Applicant emphasizes that all of the claims clearly relate to a common subject matter as discussed above. Accordingly, the recitations of each of the independent claims, as well as the various dependent claims are so closely related for examination purposes as to make the restriction requirement entirely inappropriate under any proper basis. For this reason alone, it is submitted that restriction is inappropriate and that all the claims in the present application should be examined together.

Furthermore, it is believed that the features described in each of Groups I and II are not materially different, so as to constitute distinct inventions, for examination purposes. As the Examiner must acknowledge, they all recite a substantially similar preamble and a

number of common features. Therefore, the searches must be at least somewhat overlapping for the groups. Thus, no undue burden is placed on the Examiner when examining all of the claims together. Consequently, it is believed that all the claims, i.e., 11-42 relate to a single inventive concept which share a common technical relationship.

Finally, the restriction requirement set forth by the Examiner omits one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. As set forth in MPEP § 803 "an appropriate explanation" must be set forth by the Examiner as to the existence of a "serious burden" if the restriction were not required. By virtue of the Examiner's requirement and because the claims of the various groups are so closely related, i.e, they have a technical relationship related to at least one common feature, it is submitted that there is no serious burden on the Examiner in examining all of the claims together. Furthermore, as noted above, the search for all of the claims includes at least some amount of overlap. Thus, no serious burden would come to bear on the Examiner.

For all these reasons, and consistent with the Office policy as set forth in MPEP §§ 803, 1850 and 1893.03(d), Applicant respectfully requests that the Examiner reconsider the position taken in the above-mentioned Official Action and withdraw the restriction requirement in the present application. Accordingly, the Examiner's restriction requirement is believed to be improper and has been traversed for the reasons set forth above.

Nevertheless, in order to be fully responsive, Applicant has elected with traverse the invention defined by the Examiner as Group II, and species II, directed to claims 22-30 and

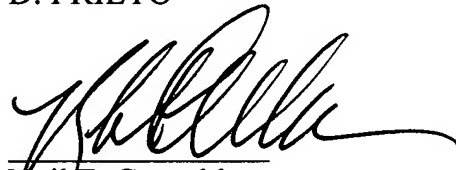
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38-42 in order to be fully responsive and in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

The Commissioner is hereby authorized to charge any fees necessary for consideration of this paper to deposit account 19-0089.

Should the Examiner have any questions or comments regarding the present response or this application, the Examiner is respectfully invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,  
D. PRIETO



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